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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/425,804	10/25/1999	DAVID G. GORENSTEIN	122144-1001	1041

7590 08/27/2002

Gardere Wynne Sewell LLP
Sanford E. Warren, Jr.
3000 Thanksgiving Tower
1601 Elm Street
DALLAS, TX 75201-4761

EXAMINER

WESSENDORF, TERESA D

ART UNIT PAPER NUMBER

1627

DATE MAILED: 08/27/2002

LD

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/425,804

Applicant(s)

GORENSTEIN ET AL.

Examiner

T. D. Wessendorf

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 13 June 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 1-39 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-4, drawn to a method of preparing achiral NF-kB, classified in class 435, subclass 6.
- II. Claims 5-10, drawn to an aptamer, classified in class 536, subclass 23.1.
- III. Claims 11-14, drawn to a method of post-selection of aptamer modification, classified in class 435, subclass 4+.
- IV. Claims 15-17, drawn to an aptamer, classified in class 435, subclass 23.1.
- V. Claims 18-22, drawn to an achiral oligo that binds to a target, classified in class 536, subclass 23.1.
- VI. Claims 23-28, drawn to an achiral oligo, classified in class 536, subclass 23.1.
- VII. Claims 29-36, drawn to a process for fractionating oligos, classified in class 536, subclass 23.1.
- VIII. Claims 32 and 34, drawn to an aptamer, classified in class 536, subclass 23.1.

- IX. Claims 33, 35, drawn to an aptamer, classified in class 536, subclass 23.1.
- X. Claims 36-38, drawn to a biochip, classified in class 422, subclass 68.1.
- XI. Claim 39, drawn to a method of assaying protein-protein interactions using biochip, classified in class 422, subclass 668.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, III, VII and XI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to different methods requiring different steps and possibly resulting in different products. For example, the method of Group I relates to a method of production of aptamers, which require only amplification method to obtain the oligos. The method of Group III requires a target compound for identifying a compound.

Inventions II, IV, V, VI, VIII, IX and X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different

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modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to different products having dissimilar structures and functions and can be produced by different methods.

Inventions (I, III, VII, XI) and (II, IV, V, VI, VIII, IX and X) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to methods for the first set of Groups and to products for the second set of Groups. These are two different statutory subject matters, therefore have different modes of operation, functions and/or effects.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and the search required for e.g., Group I is not required for e.g., Group II, restriction for examination purposes as indicated is proper.

Claims 2, 3, 5, 15, 19, 24 are generic to a plurality of disclosed patentably distinct species comprising:

If **Group I** is elected, applicants are required to elect a single species of (A). dATP, dTTP, dCTP, dGTP, dTTP, dCTP, dGTP as recited in claim 3.

If **Group II** is elected: (A) Single species of Seq. 20-28 (claim 5).

(B). mono or diphosphate (claim 6)

If **Group III**, elect (A). Mono or di thiophosphate species (Claim 12 or 13).

If **Group IV**, elect (A). Single species a-d (claim 15)

(B). Single species of Seq. ID. 17, 29, 30-39 (claims 15-17).

If **Group V**, elect (A) dATP, dTTP, dGTP and dCTP (claim 19).

If **Group VI**, elect (A) same as Group V, above (claim 24).

Each of the species recited in each particular groups or subgroups e.g., A and B differ in structure and functions therefore would have different patentability determinations.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the

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case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. D. Wessendorf whose telephone number is (703) 308-3967. The examiner can normally be reached on Flexitime.

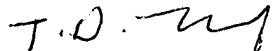
The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7924 for regular communications and (703) 308-7924 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


T. D. Wessendorf
Primary Examiner
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tdw
August 26, 2002